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Paper No. 44

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In re Application of
Gough, et al.
Application No. 08/963,239
Filed: November 3, 1997
Attorney Docket No. 13724-787
For: MULTIPLE ANTENNA ABLATION
APPARATUS AND METHOD

OFFICE OF PETITIONS
ON PETITION

This is a decision on the petition entitled, "Petition under 37 CFR 1.47(b)," filed July 21, 2003. The petition will be treated under (1) 37 CFR 1.47(a) to meet the requirement for submission of an oath or declaration under 37 CFR 1.63 executed by new inventor Edwards; (2) 37 CFR 1.183 as a request to waive 37 CFR 1.64, which requires each of the actual inventors to sign the declaration; and (3) 37 CFR 1.183 as a request for waiver of 37 CFR 1.48(a)(2), which requires new inventor Edwards to submit a lack of deceptive intent statement

The petition under 37 CFR 1.47(a) is **dismissed**.

The petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2) is **dismissed**.

The petition under 37 CFR 1.183 to waive 37 CFR 1.64 is **dismissed**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. FAILURE TO TIMELY RENEW THE PETITION WILL RESULT IN ABANDONMENT. The reconsideration request should include a cover letter entitled "Renewed Petitions under 37 CFR § § 1.183 and 1.47".

37 CFR 1.48(a) requires:

- (1) a request to correct the inventorship that sets forth the desired inventorship change;
- (2) a petition including a statement from each person being added and from each person being deleted as an inventor that the error occurred without deceptive intention on his or her part;
- (3) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47;
- (4) the fee set forth in 37 CFR 1.17 (I); and
- (5) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment;

This petition lacks (2) and (3) above.

It is logical to address (3) above first because (2) analysis flows from (3) analysis.

With respect to (3), 37 CFR 1.47 is available to meet the requirement for an oath or declaration under 37 CFR 1.63 when a new inventor (as opposed to an inventor who has already signed a declaration not listing the new inventor) refuses to cooperate. MPEP 201.03

A grantable petition under 37 CFR 1.47(a) requires

- (A) a petition including proof of the pertinent facts establishing that the joint inventor(s) refuses to join, or cannot be found or reached after diligent effort,
- (B) a proper oath or Declaration executed by the available joint inventor(s),
- (C) the fee of \$130 as specified in 37 CFR § 1.17(h), and
- (D) the last known address of the omitted inventor(s).

This petition lacks items (A) and (B) above.

As to item (A), Applicant has failed to establish that the inventor has refused to sign the declaration. The proof of the pertinent events should be made by a statement of someone with first hand knowledge of the events. The Office requires that the non-signing inventor be provided with a complete copy of the application as filed. This includes the specification with claims, drawings, if any, and a declaration. See MPEP 409.03(d).

Petitioner has shown that Stuart D. Edwards, the inventor being added to the application, received a declaration and a Statement of Inventor Being Added on April 8, 2003. However, a copy of the application did **not** accompany the documents.

Mr. Edwards must have the complete application in his possession in order to make an informed decision as to whether he joins in its filing. Mr. Edwards cannot make the necessary statements found in the declaration-- i.e. "I have reviewed and understand..." -- without having examined the patent application.

Petitioner must send Mr. Edwards a copy of the as filed above-identified application and request that the sign the declaration. When petitioner can show that Mr. Edwards was mailed or received the complete application and that he either refused to sign the declaration or would not respond to the request that he sign the declaration, petitioner will have satisfied this requirement.

As to item (B), a proper executed oath or declaration has not been presented. The declaration filed February 21, 2003 is not acceptable because it runs afoul of 37 CFR 1.64, which requires each actual inventor to execute the oath or declaration. The evidence presented lends itself to analysis under a 37 CFR 1.183 waiver of 37 CFR 1.64. The problem is that no one has signed the declaration. In this rather unusual situation where no inventor will sign a second declaration, the Office would like a properly empowered representative of the partial assignee to sign the declaration.

The Office requires submission of a newly executed declaration with the signer's name and title listed thereon in addition to the information pertaining to the inventors. As stated in the MPEP 409.03(b), where an oath is signed by a registered attorney on behalf of a corporation, either proof of the attorney's authority in the form of a statement signed by an appropriate corporate officer must be submitted, or the attorney may simply state that he is authorized to sign on behalf of the corporation.

The petition under 37 CFR 1.47(a) with respect to Mr. Edward's refusal to cooperate and his lack of execution of the declaration is **dismissed**.

The petition under 37 CFR 1.183 to waive 37 CFR 1.64, which requires each actual inventor to execute the oath or declaration is **dismissed**.

With respect to (2), the petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2) is **dismissed** because Mr. Edwards cannot state his lack of deceptive intent if he is not aware of the contents of the application. When petitioner can show that Mr. Edwards was mailed or received the complete application and that he either refused to sign the Statement of Inventor Being Added or would not respond to the request that he sign the Statement of Inventor Being Added, petitioner will have satisfied this requirement.

Regarding finance, petitioner has paid one \$130 petition fee. Petitioner owes a \$130 petition fee for the petition under 37 CFR 1.47(a), a \$130 petition fee for the petition under 37 CFR 1.183 to waive 37 CFR 1.48(a)(2), and a \$130 petition fee for the petition under 37 CFR 1.183 to waive 37 CFR 1.64. Pursuant to petitioner's authorization, deposit account no. 50-2207 will be charged two additional \$130 petition fees.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
 Commissioner for Patents
 Post Office Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 308-6916
 Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
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Telephone inquiries related to this decision should be directed to Senior Petitions Attorney E. Shirene Willis at (703) 308-6712.


Brian Hearn
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Office of Petitions